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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,337	11/06/2003	Jonathan Joseph Kaufman	64835-033	8119

7590 06/16/2004

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EXAMINER	
OLSZEWSKI, JOAN M	

ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/702,337	KAUFMAN ET AL.
	Examiner	Art Unit
	Joan M. Olszewski	3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-6 and 11-33* is/are pending in the application.

4a) Of the above claim(s) *5,6,11-20 and 33* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3,4,21-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is in response to Applicant's amendment filed May 5, 2004. Currently, claims 3-6 and 11-33 are pending in this application. However, claims 5,6, 11-20 and 33 have been withdrawn by the Examiner as being directed to a non-elected invention and species.

Election/Restrictions

Applicant's election with traverse of Group I and Species I in the amendment filed May 5, 2004 is acknowledged. The traversal is on the ground(s) that Applicants submit that the term "materially different process" must encompass a utilitarian process within the subject matter generally protectable as a utility patent and that the method claim 11 as amended cannot be practiced using a materially different product. Further, Applicants submit that the restriction requirement is improper and /or that the claims, as amended, recite a single patentable invention. This is not found persuasive because with respect to the traversal between the method and apparatus. The Examiner maintains that the two groups of inventions are separate. Basically, the method is related to therapeutic treatment while the apparatus could be used for ornamentation without any treatment. The Examiner is not destroying the device to use it solely as decorative jewelry as so suggested by Applicant. Further, looking to the classification and required search for these two inventions as identified in the restriction, they are quite divergent thus creating a burden. Accordingly, the restriction requirement will not be withdrawn. Claim 3,4 and 21-32 are considered to be directed to the elected invention and species.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The disclosure is objected to because of the following informalities: page 1, line 3, the word "pending" should be deleted and in line 4, after the word "Patent" the phrase -- 6,679,828 issued Jan. 20, 2004 -- should be inserted and "Application Serial No. 10/150,228 filed May 17, 2002" should be deleted. Further, any reference throughout the specification should be corrected accordingly.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the limitation "The magnetic key chain" in line 1. There is insufficient antecedent basis for this limitation in the claim. Further, since claim 26 depends from claim 25 it is also rejected.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3,4 and 21-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-20 of U.S. Patent No. 6,679,828. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the features of the above identified claims of the instant application are set forth in claims 7-20 of the patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3,4 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glanz (US Patent 5,782,107) in view of Pemberton (US Patent 5,050,276).

Regarding Claims 3,4 and 27-31, Glanz discloses an item of magnetic jewelry (10) comprising: a flexible tube (22) having a first and second end (Figure 1). Glanz does not show a first neodymium magnet attached to the first end of a tube or a magnetic material attached to the second end of the rubber tube. However, Pemberton teaches the use of a neodymium magnetic necklace clasp (Figure 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Glanz to include a neodymium magnetic clasp as taught by Pemberton in place of elements 38 and 40 of Glanz in order to provide an alternate fastening and unfastening means for placement and removal of the device.

Further, while Glanz does not specifically show the tube being made from rubber, this would be considered obvious since it is old and well known to form flexible tubes from rubber and well within the level of skill of one in the field.

Further, the combination of Glanz as modified by Pemberton discloses the following: re-claim 28, wherein the first magnet is inserted into the first end of the tube (Figure 3)(Glanz teaches the anchoring mechanism 20 inserted into the tube 22); re-claim 29, a first end of the first magnet is disposed within the tube and a second end of the first magnet is flush with the first end of the tube (Figure 1c)(Pemberton); re-claim 30, wherein the first magnet is engaged in an interference fit with the first end of the tube (Figure 3)(Glanz shows the anchoring mechanism in an interference fit in the end of tube 22); re-claim 31, the combination does not show a second tube or magnetic coupling arrangement for engaging the first magnet and tube. However, it is the Examiner's position that this would be merely a duplication of parts and well within the level of skill of one in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified combination of Glanz and Pemberton to include an additional tube with a magnetic coupling arrangement since one is merely

duplicating existing parts in order to increase the length of the device and well within the level of skill on one in the art.

Claims 21-26 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glanz as modified by Pemberton and further in view of Hardin (US Patent 5,691,025).

Regarding Claims 21-26 and 32, the combination of Glanz as modified by Pemberton discloses all the claimed features as discussed in the rejection above except for a hook attached by insertion into the second end of the tube and a ring attached to the hook via an aperture proximate the first end of the hook; the aperture being aligned with a corresponding aperture in the tube and the ring extending through the aperture in the tube; the hook having a first portion having a first diameter sized to be received within the second end of the tube and a second portion having a second diameter greater than the first diameter; and wherein the second diameter is about equal to an outer diameter of the second end of the tube following insertion of the hook into the second end of the tube. However, Hardin teaches a hook (Figure 1) having an aperture with a ring passing through the aperture.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Glanz as modified by Pemberton by utilizing the hook and ring arrangement as taught by Hardin in order to provide element attachment means. Further, whether the tube has an aperture aligned with the aperture on the hook first portion or whether the diameter of the second portion

of the hook is equal to the outer diameter of the tube would be obvious depending only on such factors as the desired appearance or the degree of structural integrity desired.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Feibelman (2,623,256), Chaffin, Jr. (3,086,268), Mizuno (3,129,477), Carlisle (4,128,356), Carranza et al. (5,099,659), LeFevre (5,622,293), Hardie (5,810,409), Nagler (6,093,143), Bocanegra et al. (EP 0 271 423 A1), Breuning et al. (EP 598938 A1), Shikahama (JP 09220289 A) and RU 2221522C.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joan M. Olszewski whose telephone number is 703-305-2693. The examiner can normally be reached on Monday-Thursday (5:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 3677

JMO

ROBERT J. SANDY
PRIMARY EXAMINER